



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant : Odom, W. et al.)
Serial No. : 09/977,138)
Filed : October 12, 2002)
For : Electronic Card Game)
 And Method)
Examiner : Christina Marks)

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APPELLANT'S REPLY BRIEF

Appellant, pursuant to 37 C.F.R. § 1.193(b)(1) submits his reply brief in support of his appeal of the final rejection of all claims 2–48 of the above-identified application. Appellant also requests in a separate paper an oral hearing on the appeal.

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Reply to Examiner's Argument

- In this Reply, Appellant makes four points with respect to Examiner's argument presented in her Answer Brief. First, Fuchs does not explicitly disclose carrying depletion from game to game and that Appellant's reasonable interpretation of Fuchs, contrary to Examiner's interpretation of Fuchs, does not disclose the claimed depletion across independent games.
- 10 Second, that the combination of references cited by Examiner fails to suggest the claimed limitation directed to the display of deck constituency. Third, that the Examiner's arguments

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with respect to the elimination of displayed outcomes has missed an element of the pending claims and, when that element is read in the claims, the rejection cannot be sustained. Fourth, that the Examiner has misconstrued Richardson and Appellant's arguments with respect to Richardson and that, once clarified, Examiner's rejection based on Richardson cannot be

5 sustained.

Because of the procedural posture of the claims, it is worthwhile to revisit the claimed invention. The claimed invention is a method for conducting a card game. According to the claimed invention, wagers are placed and cards are dealt. Those cards, along with replacement cards or additional cards depending upon the game, are used to resolve the wagers placed. Once 10 the wagers are resolved and the cards are no longer needed for the game in which they were dealt, the cards are removed from the deck and are unavailable until the deck is reconstituted. That is, the deck of cards is depleted of cards previously played until the deck is reconstituted. Thus, for example, if a play resulted in the deal of the cards K♦ K♣ J♣ 9♠ 6♦ 5♥ 2♦, those 15 cards would be unavailable on a subsequent unless the deck is reconstituted. All the pending claims include claim limitations directed to these features. However, certain claims include other features as well.

In one claimed feature, the constituency of the depleted deck is displayed to the player. Thus, after a certain number of hands, a player could view the constituency and know that thirty- 20 two cards remain in the deck, of which ten are hearts, seven are spades, three are Kings, one is an 8, and so forth.

In another claimed feature, the payable, which in most card games is static, is dynamic to

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illustrate that the depleted deck is incapable of forming a particular holding. For example, after a game in which the fourth and final King is removed from the deck, the holding of Royal Flush is indicated on the payable to be unavailable until the deck is reconstituted.

In yet another claimed feature, the criteria for reconstitution of the deck is set forth as (1)

- 5 on demand by the player and/or (2) on the occurrence of a predetermined criterion. Thus, a player could trigger the used cards being shuffled back into the deck and starting with an undepleted deck of cards. Alternatively or additionally, the used cards could automatically be shuffled back into the deck upon a certain occurrence, such as the penetration of the deck to a predetermined level or the play of a predetermined card from the deck.

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1. Fuchs Fails to Disclose or Suggest Depletion of Cards Across Different Hands as Recited in the Claims.

Claims 5, 11, 37, 38, and 42 all include, directly or indirectly, a claim limitation directed 15 to depletion of a card deck across multiple games. Examiner has asserted that the feature of deck depletion across multiple games is disclosed or suggested by Fuchs, U.S. Patent No. 5,630,753.

Fuchs discloses two games. First, Fuchs discloses a draw-type poker card game in which a player is dealt a hand of cards. Based on the cards selected to be held (as distinguished from those cards that will be discarded and replaced), a display is generated that shows a selection of 20 the best hands that the player could form using held cards, and assuming that the cards discarded from the hand cannot be reclaimed. The cards discarded from the hand are replaced from a deck that excludes the cards already dealt to the hand. Thus, for example, if the player is dealt and discards the 2♦, the card cannot be replaced with 2♦. In this regard, the first Fuchs game is like

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conventional video draw poker.

Second, Fuchs discloses a slot machine game in which a stable of reel symbols is defined.

The reel symbols are randomly positioned on reels and a player is allowed to hold or retain symbols for a subsequent game. Those reel symbols that “were presented in a completed first 5 game” are “deducted from the originally existing symbols.” Fuchs, col. 9, ll. 52–67. It is this disclosure that Examiner advances as showing “excluding from selection and display data for cards which have been selected and displayed” across a series of games as recited in the claims.

However, this is far from clear. One of ordinary skill in the art would reasonably interpret Fuchs as disclosing a series of *related* slot spins in which symbols are deducted and, in 10 this respect, analogous to the draw-type poker game of Fuchs in which cards are deducted across plays in a single hand. Fuchs states in the passage cited by Examiner that “[i]f, therefore, the player is given suggestions by the computer as to *which symbols to retain*, the player needs to know whether these suggestions are based on the game symbols originally present or whether they were made on the basis of the number and type of symbols predetermined for the next 15 game.” *Id.* at col. 9, ll. 35–41 (emphasis added). This is clearly a reference to a series of related slot spins in which a player is retaining symbols to attempt to build a winning outcome.

This is further supported by another passage cited by Examiner: “Thus, from game to game the symbols offered to the player would be deducted from the originally existing symbols, if some symbols appeared or were displayed more frequently; the other symbols are therefore left 20 over and occur in greater numbers in the following games *so that the player can adjust his game accordingly.*” *Id.* at col. 9, ll. 61–67 (emphasis added). Again, the passage “so that the player

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can adjust his game accordingly” simply has no meaning unless Fuchs is referring to a series of related spins. As the Board can appreciate, in a conventional slot machine, a player cannot “adjust his game.” Fuchs is referring to his game in which a player can hold certain symbols for a subsequent spin.

5 The paragraph following this passage also supports the interpretation that (a) this is not true depletion, i.e. exclusion of symbols from play and (b) these series of spins are related. Fuchs states that “[i]n order to ensure that an adequate number of game symbols *is available at all times,*” symbols can be added or reintroduced into the stable of symbols. *Id.* at col. 10, ll. 1–8. This disclosure would inform one of ordinary skill in the art that symbols are never truly depleted

10 but are cycled through the system to maintain an “adequate number of game symbols.” One can postulate that the quantities of symbols will fluctuate, but no symbol is ever truly excluded from play as recited in the claims. This, also supports Appellant’s interpretation that the spins are interrelated and, therefore, form a single hand. It only makes sense that if a player is “spinning and holding and spinning and holding ...” that additional symbols would need to be injected to

15 the stable to prevent the player from eventually winnowing the stable down to the desired winning combination. Rather than showing a series of independent trials each based on a continuously depleting deck of cards as recited in the claims, Fuchs shows conduct of a single hand played in multiple phases based on a pattern of holding, and spinning, and holding, and spinning, *et cetera.*

20 Significantly, Fuchs draws a distinction between “next game” and “new game.” *Id.* at col. 9, ll. 41–46. As suggested above, by “next game” Fuchs means the next spin in a hand after

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having the opportunity to hold symbols. By “new game” Fuchs means the *end* of the hand and restarting the cycle of holding and spinning anew with “game symbols originally present.”

Appellant also makes two additional observations about Fuchs and its disclosure. First, Fuchs is a U.S. patent that claims priority, through the Patent Cooperation Treaty, to an Austrian application. The original German-language application was published under the Patent Cooperation Treaty. In the original disclosure, Fuchs uses the phrase “nächste Spiel” which could be translated as either “next game” or “next play.” Appellant does not assert that this is conclusive of the matter, but submits that the mere use of the word “game” is not as conclusive as Examiner would assert. Examiner takes issue with Appellant’s argument of impermissible hindsight. Appellant does not impugn Examiner’s analytical ability by this argument. Rather, Appellant wishes to highlight that Examiner has given meaning to the word “game” based on the teachings of Appellant’s disclosure rather than the context of Fuchs. By looking at Fuchs on its own terms, rather than in light of Appellant’s disclosure, the word “game” can be placed in its context as a step in an overall hand, rather than a separate and independent trial.

Second, Examiner asserts that the teachings of Fuchs in the slot machine embodiment are readily translated to the card game embodiment. If the slot machine disclosure is as broad as Examiner interprets (which Appellant would assert it is not), and such a disclosure is readily translated to a card game embodiment (which, again, Appellant would assert it is not), one must wonder why Fuchs did not disclose such a method in his disclosed card game. Appellant notes that deck depletion would have been a significant departure from conventional poker that Fuchs, if he was in fact doing so, would have addressed. The Board members are likely aware that in

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any poker game, whether video draw poker at a casino, Texas Hold ‘em on television, or a friendly game at home, the deck is reshuffled after *every* hand and a continuously depleting deck is unheard of. Examiner states that it would have been known from conventional poker to use a deck as depleted by Fuchs. This is simply not the case.

5 Appellant submits that a much more reasonable interpretation of Fuchs is that the card game and slot game are, essentially, coextensive. This is supported by the claims which generally claim a gaming machine in claim 1 and in dependent claims 6 and 8 recite slot (or “fruit”) symbols and cards, respectively, for display on the gaming machine. *Id.* at claims 1, 6, and 8. Fuchs slot game, then, is properly interpreted as a draw-type slot machine in which a hand
10 consists of one or more phases in which symbols are discarded and replaced, where the replacements cannot include the discarded symbols. Properly read, Fuchs simply does not disclose exclusion of played cards across separate and independent hands as recited in the claims.

In sum, to sustain Examiner’s rejection a number of questionable assumptions must be made. One must first assume that Fuchs discloses “deduction” of symbols across separate games. However, Fuchs himself indicates that deduction occurs in the context of related games in which the player can “adjust his play” by holding or not holding certain symbols. Supposing that the first assumption can be made, one must also assume that the deduction in Fuchs is a complete exclusion. As noted, this is contradicted by Fuchs himself who states that symbols are reintroduced as needed to “ensure that an adequate number of game symbols is available at all times.” Supposing, contrary to Fuchs express statement, that the second assumption can also be made, one must further assume Fuchs can be applied to a card game, even though Fuchs himself

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did not do so. Appellant suggests that this chain of assumptions is simply too much to read into Fuchs.

Rather, Appellant submits that a much more reasonable interpretation of Fuchs is that a “hand” is conducted by spinning the reels, holding one or more of the symbols, respinning the 5 reels with the previously displayed symbols deducted, holding one or more symbols, respinning, and so forth, with injections of additional symbols as needed. For each “new game,” the original stable is used brought back. This is clearly distinguishable from the claimed invention which uses continuously depleted deck across a sequence of games. Appellant respectfully requests reversal of the rejection of representative claims 5, 11, 37, 38, and 42 which directly or indirectly 10 recite this limitation or a substantially equivalent limitation.

2. The Cited Art Fails to Show or Suggest the Display of Deck Constituency

Of the representative claims, claims 11 and 42 recite the display of deck constituency. 15 Appellant understands that Examiner has rejected this feature as obvious in view of Fuchs, either alone or in combination with Kinoshita, U.S. Patent No. 5,967,894. That is, Examiner asserts that it would have been obvious to modify Fuchs, with or without the teachings of Kinoshita, to “display[] a tally corresponding to the constituency of the deck data of said data structure depleted of said cards displayed in the play of the preceding hands” as recited in the claims. 20 Fuchs, as discussed above, discloses displaying the status of the stable of symbols during a hand of play. That is, Fuchs shows a player which “symbols are therefore left over ... so that the player can adjust his game accordingly.” Fuchs, col. 9, ll. 64–67.

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As such, Fuchs shows intragame deduction of symbols from the symbol stable. This was already discussed above and is understandable because draw poker is similarly conducted. However, since Fuchs does not show or suggest intergame depletion, it cannot show intergame deck constituency, i.e. depletion as a result of “preceding hands,” as claimed.

5 The purpose of the display highlights this distinction. In Fuchs, the purpose of the display is “so that the player can adjust his game accordingly,” i.e. by deciding which symbols to hold for the upcoming spin. *Id.* Again, this is clearly directed to intragame deduction. By contrast, the purpose of displaying deck constituency resulting from intergame depletion is to (a) show the player that cards, in fact, are being depleted and (b) inform the player as to when 10 reconstitution may occur, or should be requested to occur in one claimed embodiment.

Examiner also cites to Kinoshita in rejecting the claims containing this claim limitation. Kinoshita does not disclose the display of deck constituency or even information based on the play of “preceding hands” as claimed. Rather, Kinoshita discloses a gaming machine with an instructional display of the hands that could be formed by the player’s cards and the odds of 15 obtaining certain potential hands based on the cards held by a player. Kinoshita, col. 5, ll. 39–42. For example, a player with two pair will have a certain probability of obtaining a full house if the unmatched card is discarded and replaced. Conversely, the player will have no chance of obtaining, for example, a straight, if the two pair are held.

Appellant has trouble responding to this argument because Examiner has essentially 20 disposed of the distinction between displaying possible outcomes to showing deck constituency from preceding hands with the statement that “displaying cards over the hands is a design choice

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of one of ordinary skill in the art.” Appellant respectfully disagrees. Kinoshita discloses showing “a prize-winning hand which may possibly be achieved by the replacement of cards” in the present hand. Kinoshita, col. 5, ll. 39–41. Fuchs shows the symbols remaining for replacement within the present hand. Neither of these references, however, make that leap to

5 show the status of a depleted deck of cards based on the conduct and play of a *preceding* hand.

As with Fuchs, Appellant suggests that Examiner is interpreting Kinoshita based on the teachings of Appellant’s disclosure rather than on its own terms and in its own context. Therefore, Appellant respectfully requests reversal of representative claims 11 and 42 which include this claim limitation or a substantially equivalent claim limitation.

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3. The Cited Art Neither Shows Nor Suggests Displaying a Table of Outcomes Excluding Outcomes Eliminated by Depletion.

Among the representative claims, claims 11 and 37 recite the display of outcomes
15 excluding outcomes eliminated by intergame deck depletion. Examiner asserts that Fuchs, in combination with Kinoshita, discloses such a feature.

Let us not lose sight of what Fuchs and Kinoshita disclose. Fuchs displays to the player the replacement symbols available so that “the player can judge which game symbols he should keep for a subsequent game, if he wants to keep any at all” Fuchs, col. 9, ll. 41–46. In other words, Fuchs shows the state of the symbol stable as a result of intragame deduction. Kinoshita displays “already achieved prize-winning hands,” “a possible prize-winning hand ... and the corresponding odds,” and “impossible prize winning hands” based on the cards dealt and held. Kinoshita, col. 7, ll. 16–30. In other words, Kinoshita shows the hands attainable as a result of

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the cards held.

Examiner asserts that Kinoshita shows the exclusion of outcomes and this is true.

Kinoshita shows altering the display of a list of outcomes based on the cards held in a player hand. For example, if two pair are held, two pair (as an achieved outcome) and full house (as a 5 possible outcome) are highlighted while other outcomes, such as straight flush, are dimmed.

Kinoshita, col. 7, ll. 31–62.

However, this is not what is recited in the claims. The claims recite the exclusion of outcomes eliminated as a result of deck depletion from preceding hands. In fact, neither cited reference shows a table of outcomes excluding outcomes eliminated as a result of deck depletion 10 from preceding hands. It is only logical that if neither reference shows deck depletion from preceding hands, they cannot show a table of outcomes that excludes outcomes not attainable as a result of deck depletion from preceding hands.

Even accepting, for the sake of argument, Examiner’s position that Fuchs and Kinoshita could be combined, that combination would not give the claimed game. Without regard to 15 whether Fuchs discloses deck depletion, and Appellant would assert that it does not, Kinoshita still only shows a display of outcomes based on the player’s holding, *not* on the constituency of the deck. Kinoshita constructs a display based on the holding of X cards, that the player has A outcome already obtained, could possibly obtain B outcome, and cannot obtain C outcome. This does not tell the player whether, for example, the deck constituency could support Royal Flush or 20 four Aces as recited in the claims. It would only tell the player that if he holds a pair of nines, he cannot obtain a Royal Flush or four Aces.

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Again, Examiner's argument requires the assumption to be made that in applying Kinoshita to Fuchs, Kinoshita's table *which is explicitly based on the cards held* would be altered *so that it is no longer based on the cards held*. This, is contrary to the M.P.E.P. which directs that if a proposed modification of the prior art would change the principle of operation of the

5 prior art invention being modified, then the teachings of the reference are insufficient to render the claims *prima facie* obvious. M.P.E.P. section 2143.01.

Even accepting that Kinoshita can be altered to operate in a manner contrary to Kinoshita's express teaching, one must further assume that the altered form of Kinoshita would be based on outcomes that can be formed based on deck constituency rather than some other

10 form. This, too, is a leap since neither Kinoshita nor Fuchs shows or suggests a table of outcomes based on deck constituency let alone a table of outcomes that excludes certain outcomes resulting from deck depletion. Certainly, it is possible to make this leap in view of Appellant's teachings and Appellant would suggest that this is what Examiner has done in her rejection. However, Appellant respectfully suggests that a motivation to make such a

15 modification cannot be found in the cited art.

In sum, Kinoshita and Fuchs fail to disclose or suggest a table of outcomes in which the table is based on deck constituency and excludes outcomes that are unavailable as a result of deck depletion across games. This arises primarily from the fact that neither Kinoshita or Fuchs shows or suggests deck depletion across games. However, regardless of whether Kinoshita or

20 Fuchs shows deck depletion across games, neither reference shows or suggests the construction of an outcome table based on deck constituency. Therefore, Appellant respectfully requests

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reversal of Examiner's rejection of representative claims 11 and 37 which incorporate this claim limitation or a substantial equivalent.

4. The Cited References Do Not Show Reconstitution.

5 Claims 5 and 38 recite reconstitution of a depleted deck upon player demand and depletion of predetermined card data, respectively. Examiner has asserted that this claim limitation is shown by the combination of Fuchs, Kinoshita, and Richardson, U.S. Patent No. 5,042,809. However, Examiner relies primarily on Richardson to stand for the proposition that 10 deck reconstitution is known.

In the Appellant's Appeal Brief and Examiner's Answer Brief, Appellant and Examiner strayed from the central question of whether Richardson shows deck reconstitution. It does not.

Richardson discloses a pull tab terminal. The characteristic of a pull tab terminal, as distinguished from a slot machine, is that a predetermined quantity of winning tickets is 15 guaranteed. That is, among the X tickets loaded into the machine, there will be, with absolute certainty, Y winning tickets. In a slot machine, by contrast, each pull has Z probability of being a winning outcome, but there is no guarantee that X pulls will produce Y winning outcomes.

In Richardson, a quantity of tickets are dealt from an inventory of tickets. In the example given, nine tickets are dealt. Richardson, col. 6, ll. 62–67. Players select tickets and selected 20 tickets are revealed. *Id.* at col. 11, ll. 37–45. If a player wishes to refresh the display, a “New Deal” order causes nine new tickets to be dealt. *Id.* at col. 11, ll. 49–52. The previously revealed tickets are retired and unrevealed tickets are returned to the inventory. Once an insufficient

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quantity of tickets exists to deal nine tickets to the display, the game is retired. *Id.* at col. 12, ll. 59–62. That is, *the ticket inventory is not reconstituted*. To the contrary, “[i]f a game is retired, the player can choose another game from the master game screen, or call the operator, or quit.” *Id.* at col. 12, ll. 62–64 (internal reference numbers omitted). Reconstitution is simply not an option, whether at the player’s demand or automatically upon the occurrence of a certain event.

5 Examiner has asserted that Richardson allows for “reconstituting a dead inventory.” This is simply not the case. Richardson does allow for discarding unexposed tickets and receiving a new deal of tickets. *Id.* at col. 11, ll. 47–49. This would be analogous to, for example, folding in a card game by discarding a hand and obtaining a new hand. The inventory of tickets, analogous 10 to the deck of cards, however, cannot be reconstituted. *Id.* at col. 12, ll. 62–64. This is logical because the advantage of pull tab terminals is the predictability of the quantity of winners. If the player were allowed to reconstitute the inventory at will, the quantity of winners would be wholly unpredictable.

In sum, Richardson fails to disclose or suggest the reconstitution of an inventory. In fact, 15 Richardson explicitly states that when an inventory is dead, the game is retired and cannot be played. Since Richardson neither discloses nor suggests the reconstitution of an inventory of cards upon demand or upon occurrence of an event, Appellant respectfully submits that Examiner’s rejection of representative claims 5 and 38, which contain such claim limitations, must be reversed.

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rejections have been built on a series of assumptions about the cited references that are contrary to the references themselves. Fuchs does not disclose or suggest carrying depletion from game to game. Examiner's interpretation of Fuchs is illuminated by Appellant's disclosure and a reasonable interpretation of Fuchs clearly shows that depletion is within a single game rather than across separate and independent games. Fuchs and Kinoshita fail to show or suggest the display of deck constituency because neither display the current status of the deck based on a previously played hand. Similarly, Fuchs and Kinoshita fail to show or suggest the display of outcomes eliminated by deck depletion because neither reference shows a display based on the status of the deck, but rather on holding. Finally, Richardson explicitly teaches a game in which reconstitution is *not* available.

Appellant respectfully requests that the rejections as to all claims be reversed.

Respectfully submitted,

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